

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following remarks and discussion is respectfully requested.

Claims 1-37 are currently pending in the application. In the outstanding Office Action, Claims 1-37 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 5,982,735 to Tsai in view of U.S Patent 5,956,314 to Ishimatsu et al. This rejection is respectfully traversed.

The present invention is directed to disc drives for driving disc shaped recording medium, as well as optical disc drives for recording data on and/or reproducing data from optical discs.

Independent Claim 1 recites, in part, four receiving portions adapted to receive support for a base, the receiving portions being disposed symmetrically on the base with respect to a center line of the base along a direction of a movement of a recording and/or reading means on four corners of the base. Four supporting means are disposed in four receiving portions, at least one of the four supporting means including a support piece and an adjusting piece adapted to adjust an elasticity of the support piece.

Independent Claim 8 recites a plurality of supporting means each with an associated elastic member adapted to elastically support a base and an adjusting piece adapted to adjust an elasticity of the elastic member, the supporting means being disposed symmetrically on the base with respect to a center line of the base along a direction of a movement of an optical pickup. Four receiving portions are disposed on four corners of the base for receiving the supporting means.

Independent Claim 15 recites a base having four receiving portions on four corners. A base support member supports the base with a plurality of supporting means disposed symmetrically with respect to a center line of the base along a direction of a movement of an

optical pickup and on the receiving portions of the base, each of the supporting means including an elastic member and an adjusting piece adapted to adjust an elasticity of the elastic member.

Independent Claim 22 recites a base having four receiving portions on four corners. A plurality of supporting means are disposed on a base with an associated elastic member adapted to elastically support the base and an adjusting piece adapted to adjust an elasticity of the elastic member, the supporting means being disposed symmetrically on the base with respect to a center line of the base along a direction of a movement of an optical pickup and on the receiving portions of the base.

Independent Claim 25 recites a base having four receiving portions on four corners. At least four supporting means each have an associated elastic member adapted to elastically support the base and an adjusting piece adapted to adjust an elasticity of the elastic member, the supporting means being disposed symmetrically on the base with respect to a center line of the base along a direction of a movement of an optical pickup and on the receiving portions of the base.

Tsai is directed to a tilt angle adjusting mechanism for a compact disc recording/reproduction device. As shown in Figure 1, for example, of Tsai, several shock-absorbing elements 18 are attached to a base 10 for protecting a pick-up head 20.¹

The Office Action asserts that Figure 7 shows supporting arrangements disposed in four receiving portions 5. It is unclear from the outstanding Office Action what disclosure of Tsai is considered to be the four receiving portions and the four supporting means. That is, the Office Action discusses the receiving post portions 18 and also discusses the four receiving portions 5. Perhaps the Office Action is discussing element 50 shown in Figure 7

¹ Column 2, lines 29-31.

as there is no element 5 shown in Figure 7. Either way, Applicant respectfully disagrees with the Office Action's interpretation of the teachings of Tsai.

Specifically, in Tsai, at least one of the four supporting arrangements includes a support piece 52 and an adjusting piece (screw) 53 adapted to adjust an elasticity of support piece 52. However, Figures 6 and 7 of Tsai teach that after mounting the second guiding rod 40 in the support 50, the horizontal position of the second guiding rod 40 is fixed by the front opening 551. The screw 53 holds the end of the second guiding rod 40 from above while the spring 52 presses from below. Accordingly, the vertical position of the rod 40 is determined by adjusting the screw 53. As such, once an optimum position of the adjustment screw 53 has been found, glue is inlet through the opening 562 into the grooves 571 of the hole 57 to fix at the optimum position.

Ishimatsu et al. merely discloses that the lateral sides of the wall sections 104a, 104b facing the hollow section 105 are formed with lugs 108, 109 for preventing the compression spring 103 from being detached accidentally.

Applicant respectfully asserts that there is no motivation to combine the teachings of Tsai and Ishimatsu et al. In fact, Applicant respectfully asserts that only the present application suggests the claimed combination of features. When an obviousness determination is based on multiple prior art references, there must be a showing by the patent examiner of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references is shown is a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill

in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter." Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). Interpreting the Supreme Court's decision in Dickinson v. Zurko, 50 USPQ2d 1930 (1999) regarding the standard of review in patent matters, the CAFC determined that when upholding a rejection of a claimed invention in an appeal, the CAFC must find that the decision by the USPTO Board of Appeals and Interferences is supported by "substantial evidence," In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000). Accordingly, for a proper rejection based on a combination of references, the rejection must be supported by evidence that the motivation to combine references was not merely feasible, but desirable.

Specifically, independent Claim 1 recites "four supporting means disposed in the four receiving portions, at least one of the four supporting means comprising a support piece and an adjusting piece adapted to adjust an elasticity of the support piece." Independent Claim 8 recites "a plurality of supporting means each with an associated elastic member adapted to elastically support the base and an adjusting piece adapted to adjust an elasticity of the elastic member, the supporting means being disposed symmetrically on the base with respect to a center line of the base along the direction of the movement of the optical pickup." Independent Claim 15 recites "a base support member for supporting the base with a plurality of supporting means disposed symmetrically with respect to a center line of the base along the direction of the movement of the optical pickup and on the receiving portions of the base,

each of the supporting means including an elastic member and an adjusting piece adapted to adjust an elasticity of the elastic member.” Independent Claim 22 recites “a plurality of supporting means disposed on the base with an associated elastic member adapted to elastically support the base and an adjusting piece adapted to adjust an elasticity of the elastic member, the supporting means being disposed symmetrically on the base with respect to a center line of the base along the direction of the movement of the optical pickup and on the receiving portions of the base.” Independent Claim 25 recites “at least four supporting means each with an associated elastic member adapted to elastically support the base and an adjusting piece adapted to adjust an elasticity of the elastic member, the supporting means being disposed symmetrically on the base with respect to a center line of the base along the direction of the movement of the optical pickup and on the receiving portions of the base.”

There is no advantage that would be obtained by modifying support piece 50 or 18 of Tsai with the spring of Ishimatsu. For example, as discussed above, Tsai teaches that the second guiding rod 40 is fixed in the support 50. The screw 53 holds the end of the second guiding rod 40 from above while the spring 52 presses from below. Once an optimum position of the adjustment screw 53 has been found, glue is inlet through the opening 562 into the grooves 571 of the hole 57 to fix the optimum position. Accordingly, there is no motivation to add the adjusting piece of Ishimatsu to the support 50 of Tsai as the support 50 of Tsai is fixed by glue. That is, adding the adjusting piece of Ishimatsu would render the support 50 of Tsai unfit for its intended purpose, which is to be fixed in place.

Additionally, there is nothing in either Tsai or Ishimatsu, or the general level of skill in the art to support adding the adjusting piece of Ishimatsu would improve the support piece 18 of Tsai, as the support piece 18 is sufficient to accomplish its stated purpose. Nor is there any clear showing that the resulting combination would correspond to the subject matter recited in the independent claims.

Thus, for the above reasons, Applicant respectfully requests that the rejection of independent Claim 1, 8, 15, 22, and 25 under 35 U.S.C. § 103(a) be withdrawn, and the allowance of independent Claims 1, 8, 15, 22, and 25.

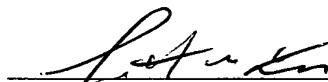
Claims 2-7, 9-14, 16-21, 23, 24, and 26 depend from independent Claims 1, 8, 15, 22, and 25, and are therefore also allowable for at least the same reasons as the independent claims, as well as for their own features. Thus, Applicant respectfully requests that the rejection of dependent Claims 2-7, 9-14, 16-21, 23, 24, and 26 under 35 U.S.C. § 103(a) be withdrawn and the allowance of the dependent claims.

Consequently, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance for Claims 1-37 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below-listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073
Kevin McKinley
Registration No. 43,794

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
KMM/rac

I:\ATTY\KMM\PROSECUTION WORK\20S\203744\AMDT DUE 13SEPT05.DOC

Scott A. McKeown
Registration No. 42,866